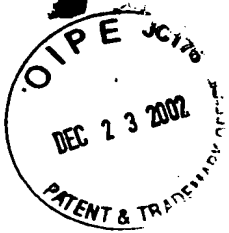


2855



[10537/120]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: EICKHOFF et al.
Serial No.: 09/905,583
Filed: July 13, 2001
For: **A PRESSURE SENSOR, A METHOD FOR MANUFACTURING
A PRESSURE SENSOR AND A COMBUSTION ENGINE
HAVING A PRESSURE SENSOR**
Examiner: FERGUSON, Marissa L.
Art Unit: 2855

Commissioner for Patents
Washington, D.C. 20231

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Commissioner for Patents, Washington, D.C. 20231.
Dated: December 18, 2002
Signature: *Mary C. Uenver*

TRANSMITTAL

SIR:

Please find a Response to Restriction Requirement transmitted herewith for filing in the above-identified patent application.

No fee is believed to be required. However, if any fee is required, please use Deposit Account No. **11-0600**. A duplicate of this transmittal letter is enclosed for that purpose.

Respectfully submitted,

Richard L. Mayer

Dated: December 18, 2002

By: *Mary C. Uenver* Reg No. 70,333
Richard L. Mayer
Reg. No. 22,490

KENYON & KENYON
One Broadway
New York, NY 10004
Telephone: (212) 425-7200
Facsimile: (212) 425-5288

RECEIVED
DEC 26 2002
TECHNOLOGY CENTER 2800



#6/Elective
12/31/02

Docket No. 10537/120

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR : Martin EICKHOFF et al.
SERIAL NO. : 09/905,583
FILED : July 13, 2001
FOR : A PRESSURE SENSOR, A METHOD FOR
MANUFACTURING A PRESSURE SENSOR AND A
COMBUSTION ENGINE HAVING A PRESSURE
SENSOR
GROUP ART UNIT : 2855
EXAMINER : Marissa Ferguson

Commissioner for Patents
Washington, D.C. 20231

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Dated:

December 18, 2002

Signature:

Richard L. Mayer (Reg. No. 22,990)

42, K9

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. § 121

SIR:

In response to the Office Action dated November 18, 2002, Applicants provisionally elect with traverse the invention of Group I, i.e., claims 1 to 22 and 28 to 49. Examination of all three groups concurrently is requested, given the commonality of subject matter among the three groups.

The Manual of Patent Examining Procedure (M.P.E.P.) sets forth the requirements for a proper restriction requirement. In particular, the M.P.E.P. states:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP Section 802.01, Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 - Section 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP Section 803.02, Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02).

RECEIVED
DEC 26 2002
TECHNOLOGY CENTER 2800

(M.P.E.P. § 803 (emphasis added)). The fact that *both* criteria must be satisfied is made all the more clear by the following statement in the M.P.E.P.:

If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.

(M.P.E.P. § 803 (emphasis added)). Thus, if the subject matter of the pending claims is such that there would be no serious burden on the examiner to search and examine all of the pending claims at the same time, the examiner is to do so, *even if* the pending claims are drawn to independent or distinct inventions.

The Office Action states that “Groups I [(i.e., claims 1 to 22 and 28 to 49)] and II [(i.e., claims 23 to 27)] are related as process of making and product made” but contends that “the product as claimed can be made by a materially different process such as welding.” Office Action at p. 2. The Office Action does not, however, even allege which, if any, elements of the pressure sensor as claimed in claim 1 “can be made by a materially different process such as welding.” The pressure sensor as claimed in claim 1 includes “a housing having an interior chamber[,] a diaphragm sealing the interior chamber[,] a deformable first measuring element coupled to the diaphragm[,] and an arrangement coupled to the first measuring element, the arranged being configured to generate a signal in response to a deformation of the diaphragm and to generate a signal in response to a deformation of the first measuring element.” The method of manufacturing a pressure sensor as claimed in claim 23 includes the steps of “providing a housing having an interior chamber, the interior chamber being sealable by a diaphragm[,] providing a support structure configured to support at least one first bendable measuring element on an upper side thereof[,] inserting the support structure and the first bendable measuring element into the housing[,] and sealing the interior chamber.”

The Office Action further states that the “[i]nventions of Groups I and Group III [(i.e., claims 50 to 71)] are related as combination and subcombination.” Office Action at page 2. The Office Action alleges that “the combination as claimed does not require the particulars of the subcombination as claimed because pressure sensor [sic] does not require welding a diaphragm structure” and that “[t]he subcombination has separate utility such as welding.” Office Action at pages 2 to 3.

The foregoing contentions belie the plain language of the claims. As indicated above, the pressure sensor as claimed in claim 1 includes "a housing having an interior chamber[,] a diaphragm sealing the interior chamber[,] a deformable first measuring element coupled to the diaphragm[,] and an arrangement coupled to the first measuring element, the arranged being configured to generate a signal in response to a deformation of the diaphragm and to generate a signal in response to a deformation of the first measuring element." The combustion engine as claimed in claim 50 includes "a pressure sensor configured to measure a pressure in the combustion chamber" and recites that the pressure sensor includes "a housing having an interior chamber[,] a diaphragm sealing the interior chamber[,] a deformable first measuring element coupled to the diaphragm[,] and an arrangement coupled to the first measuring element, the arrangement being configured to generate a signal in response to a deformation of the diaphragm and to generate a signal in response to a deformation of the first measuring element." Thus, it cannot be said that "the combination as claimed [in claim 50] does not require the particulars of the subcombination as claimed [in claim 1]." Moreover, neither claim 1 nor claim 50 requires "welding a diaphragm structure," and any reference to such welding is misplaced. The statement that "[t]he subcombination has separate utility such as welding" is not understood, since none of the claims of Groups I and III require or refer to welding.

Still further, as set forth in 37 C.F.R. § 1.141(b), "[w]here claims to all three categories, product, process of making, and process of use, are included in a national application, a three way requirement for restriction can only be made where the process of making is distinct from the product." (emphasis added). However, 37 C.F.R. § 1.141(b) further sets forth that "[i]f the process of making and the product are not distinct, the process of using may be joined with the claims directed to the product and process of making the product even though a showing of distinctness between the product and process of using the product can be made."

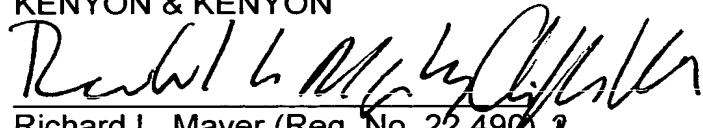
In view of all of the foregoing, it is respectfully submitted that the three way restriction is improper, and reconsideration and withdrawal of the restriction requirement is respectfully requested.

Dated: December 18, 2002

By:

Respectfully submitted,

KENYON & KENYON


Richard L. Mayer (Reg. No. 22,490)

One Broadway
New York, New York 10004
(212) 425-7200

Reg. No.
42,179

CUSTOMER NO. 26646



26646

PATENT TRADEMARK OFFICE